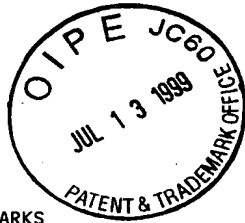


In re Application of: ARIYASU et al
 Application No.: 09/063,778
 Filed: April 22, 1998
 For: HEDGEHOG PROTEIN



Art Unit: 1646
 Examiner: C. Kaufman
 Washington, D.C.
 Atty.'s Docket: ARIYASU=1
 Date: July 13, 1999

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THE COMMISSIONER OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231

Sir:

Transmitted herewith is a ☐ Amendment ☒ Reply to Restriction Requirement in the above-identified application.

☐ Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.

☐ A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.

☒ No additional fee is required.

The fee has been calculated as shown below:

(Col. 1)		(Col. 2)		(Col. 3)	SMALL ENTITY		OR	OTHER THAN A SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE		RATE	ADDITIONAL FEE
TOTAL	*	MINUS	**	=	x 9	\$		x 18	\$
INDEP.	*	MINUS	***	=	x 39	\$		x 78	\$
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+130	\$		+ 260	\$
					TOTAL	\$	OR	TOTAL	

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

☒ Conditional Petition for Extension of Time

If any extension of time for a response is required applicant requests that this be considered a petition therefor.

☐ It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

- ☐ First - \$ 55.00
☐ Second - \$190.00
☐ Third - \$435.00
☐ Fourth - \$680.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

- ☐ First - \$ 110.00
☐ Second - \$ 380.00
☐ Third - \$ 870.00
☐ Fourth - \$1360.00

Month After Time Period Set

☐ Less fees (\$) already paid for month(s) extension of time on .

☐ Please charge my Deposit Account No. 02-4035 in the amount of \$.

☐ A check in the amount of \$ is attached (check no.).

☒ The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR Section 1.16 and all patent processing fees under 37 CFR Section 1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR Section 1.18.

BROWDY AND NEIMARK, P.L.L.C.
 Attorneys for Applicant(s)

By: 

SHERIDAN NEIMARK
 Registration No. 20,520

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Art Unit: 1646
ARIYASU et al) Examiner: C. Kaufman
Appln. No.: 09/063,778) Washington, D.C.
Filed: April 22, 1998) July 13, 1999
For: HEDGEHOG PROTEIN) Atty.Docket: ARIYASU=1

REPLY TO RESTRICTION REQUIREMENT

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Replying to the Office Action of June 16, 1999,
primarily in the nature of a requirement for restriction,
applicants hereby provisionally and respectfully elect, with
traverse and without prejudice, Group I directed to the hedgehog
protein, and presently comprising claims 1-6.

The requirement is traversed at the present time on the
basis that an examination of plural groups would not involve a
serious burden, for the following reasons. Even though the groups
are separately classified, a complete examination of the Group I
claims will also require at least a consideration of Group II, and
particularly the method of producing the protein by expression of
the DNA, as well as the DNA. If such subject matter of Group II
must be considered for a complete examination of the elected Group
I claims, then it would take only very little additional work to
also examine those claims. Such little additional work would not
be a serious burden (MPEP §803, second paragraph), even in view of
the separate classification.

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As between Groups I and III, the PTO has invariably taken the position that an antibody is not patentably distinct from the protein as it would be obvious to make an antibody to any known protein.¹ Clearly, if the antibody is obvious from the protein, they are not patentably distinct and restriction in such a case is not proper, In re Lee, 199 USPQ 108 (1978), where the Deputy Assistant Commissioner for Patents stated in part as follows:

... It is important from the standpoint of public interest that no restriction requirements be made which might result in the issuance of two patents for the same invention. The nullification of double patenting as a ground of rejection provided for in the third sentence of 35 USC 121 imposes a heavy burden on the Office to guard against erroneous requirements for restriction where the claims define essentially the same invention and which if acquiesced in, might result in more than one patent for essentially the same invention

Accordingly, the restriction should also be withdrawn between Groups I and III.

Acknowledgment by the PTO of the receipt of applicants' papers filed under Section 119 is noted.

¹ Applicants do not concede that this is necessarily so, but only that this is a standard position taken by the PTO.

In re Appln. No. 09/063,778

Applicants respectfully request that the restriction requirement be withdrawn at least in part, and that examination proceed on the basis of plural groups.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.

Attorneys for Applicant(s),

By:


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